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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,827	03/04/2004	Patrick Arachequesne	P24953	3641

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EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,827

Applicant(s)

ARACHEQUESNE, PATRICK

Examiner

Michelle (Shelley) Clement

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-18 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species a, Figures 1 & 2, in the reply filed on 12/2/05 is acknowledged.
2. Claims 6-9 and 19-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim (the species of Figures 1 & 2 are not disclosed or shown to include a locking screw or an inclined ramp). Election was made **without** traverse in the reply filed on 12/2/05.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 10-18, 22, 23, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a support configured to support a sight, does not reasonably provide enablement for the support configured to support a sight **substantially on the sighting axis**. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The Figures, 1-4, clearly show the sight (6 & 33) supported above the sighting axis (the virtual line passing from the back sight to a fore sight ¶ 2) and the specification discloses that the fore sight (36) can pass under the support ¶ 30; it is not

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clear to the examiner, how the support is configured to support a sight on the sighting axis as defined by the applicant **AND** the fore sight still be capable of passing under the support, and applicant's figures clearly show the sight above the sighting axis. Furthermore, applicant has the term **substantially** is a relative term which applicant has not defined in the specification or in the claim and it is not clear to the examiner what constitutes "substantially" since applicant's figures clearly show that the sight is not on the sighting axis as defined by the applicant.

6. Claims 1-5, 10-18, and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the back sight and the fore sight OR a rib. Applicant has disclosed that the sighting axis is defined as "the virtual line passing from a *back sight* to a *fore sight*, or simply corresponding to a *rib* of a shotgun" (§ 2, emphasis added), since applicant is claiming the sighting axis and has disclosed that the sighting axis cannot exist without a back sight and fore sight OR a rib and one of ordinary skill in the art would not know which sighting axis applicant is claiming, applicant must claim the elements required to define the claimed **sighting axis**.

7. Claim 1-5, 10-18, and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The term "substantially" in claims 1, 13 and 25 is a relative term which renders the claims indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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9. Claim 1 recites the limitation "the firearm" in line 4, "said holographic sight" in line 5, and "said sighting axis" in line 8. There is insufficient antecedent basis for this limitation in the claim in that applicant has not previously positively recited these elements.

10. Claim 13 recites the limitation "the support" in line 5. There is insufficient antecedent basis for this limitation in the claim in that applicant has not previously positively recited this element.

11. Claims 1-5, 10-18, and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite in that it is not clear whether the holographic sight and firearm are intended to be encompassed by the claim language. The preamble and claim language sets out a mount or mounting intended to be used with a holographic sight and a firearm but applicant's continued switching between intended use language, and language such as "said holographic sight" and "the sight" or "the firearm" make it unclear whether applicant is claiming the combination of the mount with the firearm and sight. As such the metes and bounds of the claims cannot be determined.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, 11, 13, 22, 23, 25, and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Solinsky et al. (US Patent # 6,185,854). Solinsky et al. discloses a mounting (that

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could be used for any type of sight, including a holographic sight, on a firearm), the mounting comprising a support with at least one fastener that fixes one end of the support laterally to a firearm in a vicinity of a muzzle end of a barrel of a firearm, and the support supports a sight at an other end, wherein the support is configured so that the end supporting the sight is positioned above the firearm and the sight is on a sighting axis. The firearm comprises an automatic pistol having a mobile slide. The support is arc-shaped and includes an attachment that attaches the arc-shaped support to a firearm. It is inherent that the firearm would have a sighting axis (i.e. any axis in which a person firing the firearm uses to aim the firearm). Solinsky et al. further discloses the method of using the claimed device. The [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference since the reference is capable of performing in the desired manner. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-5, 11, 13-18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolfe-Martin (US Patent # 1,198,665) and Bechtel (US Design Patent # 291,468). Rolfe-Martin discloses a mounting (that could be used for any type of sight, including a holographic sight, on a firearm), the mounting comprising a support with at least one fastener that fixes one end of the support laterally to a firearm *in a vicinity of* (the support has the ability of being fixed at any location on a firearm) a muzzle end of a barrel of a firearm, and the support supports a sight at an other end, wherein the support is configured so that the end supporting the sight is positioned above the firearm and the sight is on a sighting axis (any axis in which a shooter uses to aim a firearm is a "sighting axis"). The mount comprising a strip coupled to the support, wherein the firearm has a lateral dovetail groove on a fixed portion and the strip is configured to be inserted into the dovetail groove and at least one fastener is structured and arranged to immobilize the strip in the groove, and an attachment strip structured and arranged to be fixed to the firearm to form the dovetail groove and the attachment strip incorporating the dovetail groove and including holes for fixing screws. The dovetail groove terminates at an abutment that is at the same end as a muzzle end of a barrel of the firearm. Although Rolfe-Martin does not

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expressly disclose the support being arc-shaped, Bechtel does. Bechtel teaches a mount for a firearm wherein the mount is arc-shaped. Rolfe-Martin and Bechtel are analogous art because they are from the same field of endeavor: sight mounts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the arc-shaped mount as taught by Bechtel with the attachment and mount as taught by Rolfe-Martin. The suggestion/motivation for doing so would have been to obtain a sight mount that was adaptable to various firearms. It is inherent that the firearm would have a sighting axis (i.e. any axis in which a person firing the firearm uses to aim the firearm). The [a) statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference since the reference is capable of performing in the desired manner. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

15. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolfe-Martin and Bechtel as applied to claims 1 and 13 above, and further in view of DePaoli (US Patent # 5,373,644). Although neither Rolfe-Martin nor Bechtel expressly disclose the mount in combination with a holographic sight, DePaoli does. DePaoli teaches a holographic sight coupled with a mount for a sight. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the attachment device as taught by Rolfe-Martin and Bechtel with the holographic sight of DePaoli. The suggestion/motivation for doing so would have been to obtain a holographic sight that could be easily attached to a firearm.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bechtel (US Patents # 5,107,612, #4,367,606 & US Design Patents # 318, 708, # 291,469), Van Holten (US Patent # 4,044,486), Idan (US Patent # 4,665,622), Morris (US Patent # 4,346,995), Shelley (US Patent # 2,425,130), Ekstrand (US Patent # 3,942,901) Mauser (US Patent # 1,132,105) Harper (US Patent # 2,810,963), Tai et al. (US Patent # 5,483,362), Goldstein (US Patent # 4,764,011) Kay et al. (US Patent # 5,594,584 & # 5,813,159), Karow (US Patent # 4,894,941), Strahan (US Patent # 4,418,487) Singletary (US Patent # 4,878,307), Felix (US Patent # 2,583,260), Castellano (US Patent # 4,174,581) and Haugen et al. (US Patent Application # 2005/0217161).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHELLE CLEMENT
PRIMARY EXAMINER